



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,259	12/21/2005	Jackie Papkoff	DEX0491US.NP	9408
32800 7590 03/25/2008 LICATA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053				
EXAMINER NATARAJAN, MEERA				
ART UNIT		PAPER NUMBER		
1643				
NOTIFICATION DATE		DELIVERY MODE		
03/25/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poreilly@licataandtyrrell.com

## Office Action Summary

**Application No.**

10/562,259

**Applicant(s)**

PAPKOFF ET AL.

**Examiner**

MEERA NATARAJAN

**Art Unit**

1643

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6, 8, 10, 16, 19, 20, 22, 23, 30, 31, 35, 37, 39, 47, 61-63 and 72-81 is/are pending in the application.
- 4a) Of the above claim(s) 30, 31, 35, 37, 39, 47 and 61-63 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 74-81 is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 10, 16, 20, 22, 72 and 73 is/are rejected.
- 7) ☒ Claim(s) 6, 19 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendments in the reply filed on 01/10/2008 is acknowledged and entered into the record.
2. Claims 1-3, 6, 8, 10, 16, 19, 20, 22, 23, 30, 31, 35, 37, 39, 47, 61-63, 72-81 are pending. Claims 30, 31, 35, 37, 39, 47, and 61-63 have been withdrawn as directed to non-elected inventions.
3. Claims 1-3, 6, 8, 10, 16, 19, 20, 22, 23, and 72-81 will be examined on the merits.

***Claim Rejections Maintained - 35 USC § 102***

4. The rejection of Claims 1, 3, 16 and 20 under 35 USC 102 as being anticipated by Antalis et al., Bandman et al., is maintained for the reasons of record. Applicant's argue Antalis et al. and Bandman et al. do not teach antibodies that have the characteristic of binding to Pro104 (also known as testisin) on a mammalian cell "in vivo". Applicant's arguments have been carefully considered but are not deemed persuasive to overcome the rejection of record.
5. Both Antalis et al. and Bandman et al. teach Pro104 antibodies (known as either testisin or have the same sequence). Antalis et al. discloses the potential use of testisin antibodies as a therapeutic target, suggesting in vivo use of the antibody. Bandman et al. disclose antibodies which specifically bind HUPM may be used for the diagnosis of disorders characterized by expression of HUPM (see column 33). Although Antalis et al. and Bandman et al. do not specifically state the antibodies would bind in vivo, this limitation of the claim is a characteristic of a Pro104 antibody and is an inherent

Art Unit: 1643

characteristic. Therefore, one of ordinary skill in the art would envisage any Pro104 antibody would maintain this characteristic. The burden is therefore shifted to the Applicant to prove that the antibodies taught by Antalis et al. and Bandman et al. would not bind *in vivo*. Therefore, the rejection of the claims under 35 USC 102(b) as being anticipated is maintained for the reasons of record.

***Claim Rejections Maintained - 35 USC § 103***

6. The rejection of Claims 1-3, 8, 10, 16, 20, 22 and new claims 72 and 73 under 35 USC 103(a) as being unpatentable over Bandman et al. in view of Queen et al. is maintained for the reasons of record. Applicant's argue Bandman et al. does not teach an antibody that binds to Pro104 on a mammalian cell *in vivo* and Queen et al. does not remedy this deficiency of Badman et al. Applicant's arguments have been carefully considered but are not deemed persuasive to overcome the rejection of record.

7. As stated above, Bandman et al. disclose antibodies which specifically bind HUPM (which has the same sequence as Pro104) may be used for the diagnosis of disorders characterized by expression of HUPM (see column 33). Although Bandman et al. does not specifically state the antibodies would bind *in vivo*, this limitation of the claim is a characteristic of a Pro104 antibody and is an inherent characteristic. Therefore, one of ordinary skill in the art would envisage any Pro104 antibody would maintain this characteristic. The burden is therefore shifted to the Applicant to prove that the antibodies taught by Bandman et al. would not bind *in vivo*. Queen et al. provides support for the limitations of a humanized antibody conjugated to toxins or a

Art Unit: 1643

detectable label. Therefore, the rejection of the claims under 35 USC 103(a) as being unpatentable over Bandman et al. in view of Queen et al. is maintained for the reasons of record.

**All other rejections are withdrawn in view of the applicant's amendments and arguments thereto as set forth in the reply filed 01/10/2008.**

### ***Conclusion***

8. Claims 6, 19, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 74-81 are allowed.
10. Claims 1-3, 8, 10, 16, 20, 22, 72 and 73 are rejected.
11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1643

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEERA NATARAJAN whose telephone number is (571)270-3058. The examiner can normally be reached on Monday-Thursday, 9:30AM-7:00PM, ALT. Friday. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN

/Larry R. Helms/  
Supervisory Patent Examiner, Art Unit 1643